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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,648	09/10/2003	Benedict F. Marnocha	35109/82668	3664

7590

08/17/2004

Barnes & Thornburg  
600 One Summit Square  
Fort Wayne, IN 46802

EXAMINER
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PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,648	<b>Applicant(s)</b> MARNOCHA, BENEDICT F.	
	<b>Examiner</b> Sebastiano Passaniti	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/16/04; 04/09/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 09/10/2003 – application papers filed; 12/22/2003 – Oath; 01/16/2004 IDS; 04/09/2004 – IDS.

Claims 1-20 are pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase and Taylor. Yang discloses the invention substantially as claimed, but lacks a non-light-producing insert. In order to maintain the “regulation” status of the club head and to avoid altering the performance of the head, it would have been obvious to replace the light-producing-insert with a non-light-producing insert, since it has been shown to be old in the art to modify a club head putter for practice purposes and to further transform the putter into an arrangement that is intended for regulation play. In this regard, the patent to Bontomase is cited to show that the practice sighting element held within a cavity within the head is “replaced” with a core that in this case is inverted so that there is no depreciable weight shift in the putter head while at the same time making the putter head legal for regulation play. Of further significance is the patent to Taylor, which is cited to show in an analogous fashion that the tip for a cue that has been altered for practice is reverted back to its

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original design. The modification creates no appreciable change in the weight, shape or balance of the cue (col. 2, lines 43-55 in Taylor). Specific to claims 10 and 12, see col. 1, lines 48-58 in Yang. As to claim 13, the skilled artisan would have found it obvious to provide any convenient structure for holding the insert within the club head during use. The use of a snap fit is not deemed to patentably define over the arrangement used in Yang or even Yang as modified by Bontomase.

Claims 4-9, 14, 15, 17, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud and Stock. Yang in view of Bontomase and Taylor has been discussed. To have further modified the device in the cited art reference to Yang by including a prism and a target that reflects the laser beam initiated from the putter head so that a golfer may have a distinct line of sight (i.e., path of light to follow) between the putting face and the intended target would have been obvious in view of the patent to Stock, which shows it to be old in the art to provide a laser apparatus with a prism for to target the highly directional beam of light from the putter face to the target. See col. 5, line 28 through col. 6, line 14 in Stock. Further, the use of a target to reflect the laser beam, as required by claims 7, 9 and 14 and more specifically the use of a target with markings as required by claim 15 would have been obviated by the Cloud teaching. See Figure 6 and col. 3, lines 48-65 in Cloud. Specific to claim 4, to have positioned a transparent material over the aperture (13) in the Yang device merely to protect the laser light or diode or structure behind the face from damage that might have occurred during an impact with a golf ball would have been obvious and would have further involved nothing more than common sense.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and Vargo. Yang in view of Bontomase and Taylor has been discussed above. To have further modified the device in the cited art reference to Yang by locating the aperture associated with the light-producing-insert closer to the midpoint of the ball-striking face in order to help a golfer focus on lining up the center or sweet spot of the club head with an intended target would have been obvious in view of the patent to Vargo, which shows it to be old in the art to include a laser light insert situated adjacent the center of the striking face in order to improve a golfer's putting ability. See Figure 1 in Vargo, which discloses that the light will be emitted through the front face proximate the center of the ball-striking face.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud, Stock and Gross. To have further modified the Yang device by including a target that is accommodated within a golfing hole so that the golfer's sight is focused on the end target and not perhaps on an intermediate location somewhere ahead of the golfing hole would have been obvious in view of the patent to Gross, which shows it to be old in the art to include a reflective target (64) mounted to a flagstaff that is to be mounted within a golfing hole. The arrangement provides a light source to focus a light path from the striking face to the reflective target. See Figure 5A in Gross.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vargo in view of Au. Although Vargo does not specifically reference a non-light-producing insert, it is well recognized that putters are often modified for training purposes and may

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include the introduction into a cavity within the club body of at least one insert or a plurality of diverse inserts to suit the practice needs of a golfer. In this regard, Au is cited to show the commonness of including multiple inserts within a club head for practice purposes, whereby the golf club head may be modified as needed by a golfer. Thus, it would have been obvious to modify the Vargo device by simply including or adding another type of insert within the head, the motivation being to provide a further practice putting head scenario.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anderson is cited to show a putter head that is modified by including various inserts therein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
August 16, 2004